

Remarks

This Response is responsive to the Office Action of **September 22, 2005**. Reexamination and reconsideration of **claims 1-31** is respectfully requested.

Summary of The Office Action

Applicant's 1.131 Declaration and evidence submitted were purportedly insufficient to establish a conception of the invention prior to the effective date of Wong et al.

Claims 1-8, 10-11, and 13-31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Wong et al. (U.S. Pat. No. 6,636,203).

Claims 9 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong et al. (U.S. Pat. No. 6,636,203) in view of Towle (U.S. Pat. No. 6,522,765).

Response to Final Office Action

The Final Office Action maintains the rejections based on Wong et al. and states that the evidence submitted with the 1.131 Declaration was purportedly insufficient to establish a conception of the invention prior to the effective date of Wong et al.. Furthermore, the Final Office Action stated that Applicant's 1.131 Declaration purportedly has no nexus to many claimed features such as: a controller controlling the communications device and comprising an apparatus that generates the icons.

Applicant respectfully submits that the 1.131 Declaration and the evidence submitted are sufficient to establish a conception of the invention prior to the effective date of Wong et al.. A comparison of the claimed features to the evidence submitted is shown below. Additionally, Applicant finds no statutory authority for rejecting the Declaration as having "no nexus" to the claimed features. Indeed, the Examiner did not cite any authority for this position.

In fact, the MPEP contradicts the “no nexus” analysis with MPEP 715.02 entitled “How Much of the Claimed Invention Must Be Shown”.

MPEP 715.02 states:

Further, a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity. See *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art.

A simple comparison of the evidence submitted to the claimed features shows that the evidence establishes reduction to practice of the claimed invention and/or conception of the invention prior to the effective date of the reference coupled with due diligence. The evidence was submitted in Applicant's previous response and is entitled “Hewlett-Packard Company Invention Disclosure” (hereinafter referred to as “the Invention Disclosure”).

Claim 1

Claim 1 recites “a communications device comprising a transmitter that converts electrical representations of aural signals into signals for transmission over a medium and a receiver that receives communication signals for conversion into representations of aural signals.” The Invention Disclosure describes a “Buttonless cellular phone/module” in the “Title” of the invention in section 1 on page 1. Pages 2 and 3 show a cellular phone with an antenna and section 5 describes “this would allow a PDA or other wireless device to double as a cellular telephone, without a designated keypad.” A PDA/cellular phone supports the claimed

“communications device” and the disclosed antenna and wireless capabilities support the claimed “transmitter” and “receiver.” One of ordinary skill in the art clearly would understand that a cellular phone includes a “transmitter” and “receiver” as claimed. This is the function of an antenna and its corresponding circuitry. Thus, these claimed features are supported by the Invention Disclosure and clearly demonstrate reduction to practice and/or conception of the invention to one of ordinary skill in the art.

Claim 1 further recites “a touch-screen display comprising icons representing numbers that are used to enter at least a number in response to a contact area, on the display, over a particular icon to be entered.” In this regard, the Invention Disclosure states:

“Created an interface for the PDA type device that allows an individual to press the keypad on the display to enable dialing. The displayed keys may be raised to enable a tactile response.” (page 2, section 5)

“In the example 2, below, a phone icon appears, when depressed, a keypad number scheme is displayed, and a phone number can be entered.” (Page 3, section 7).

As MPEP 715.02 states, identical subject matter is not required in the evidence and what would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence is a sufficient showing. The Invention Disclosure describes having a displayed number keypad and pressing the number keypad on the display to enter a phone number. This describes the claimed touch-screen display with numbers as claimed.

Lastly, claim 1 recites “a controller” that is coupled to the other claimed components and is configured to function in the claimed manner. Although the Examiner indicated that the declaration has “no nexus” to the claimed controller, this is not the standard for 1.131 Declarations. As stated above, MPEP 715.02 states:

Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art.

It will be appreciated that the claimed communications device is an electronic device that is configured in a unique way with unique features. One of ordinary skill in the art understands

that electronic devices including PDA's and cell phones can be implemented with features using a controller such as a microprocessor configured or programmed in the specified manner. This is how electronic devices are implemented. Therefore, although a controller is not specifically called out in the Invention Disclosure, a controller is a variation and adaptation which would have been obvious to one of ordinary skill in the art as allowed by MPEP 715.02. The claimed features of the controller are described or are obvious from at least section 7, page 3 of the Invention Disclosure.

Referring again the Final Office Action, it also states that "claimed features such as a speaker, a microphone and a low power wireless transceiver are not even mentioned in the 1.131 declaration." (page 7). Applicant respectfully submits that the evidence submitted (the Invention Disclosure) describes these features, which are all components of a cellular telephone, for example. Thus, the Invention Disclosure establishes conception as required. Applicant believes there is no requirement for the 1.131 Declaration to repeat the entire content of the evidence submitted. The Invention Disclosure speaks for itself and its teachings cannot be ignored simply because its content is not repeated in the Declaration. MPEP 715.02 directly supports this position.

Claims 2-31

Performing a similar comparison of the remaining claims with the submitted Invention Disclosure also demonstrates that the Invention Disclosure either describes or makes obvious the present claims. Therefore, the submitted evidence establishes conception of the invention by at least May 17, 2000 (see the "Initiator Date" field showing when the submitted Invention Disclosure was prepared by the present inventor).

The Examiner has clearly spent much time and effort analyzing the content of the cited references to determine what they teach as related to the present claims. Applicant respectfully requests that the Examiner also carefully review the content of the submitted Invention Disclosure and determine what it teaches and what it makes obvious to one of ordinary skill in the art as related to the present claims. Applicant respectfully believes that the 1.131 Declaration and the Invention Disclosure establish conception of the invention prior to the effective date of

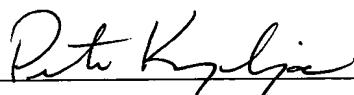
the Wong patent. Thus, the Wong Patent should be removed as a reference and the rejections be withdrawn.

Conclusion

For the reasons set forth above, **claims 1-31** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

Nov. 16, 2005



PETAR KRAGULJAC (Reg. No. 38,520)
(216) 348-5843